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In Re: **Patent No. 6221836**
Issue Date: **April 24, 2001**
Application No.: **09/213,968**
Filing Date: **December 17, 1998**

First Named Inventor: **Paxton Beale**

Assignee of All Right and Interest: **Paxton Beale**

**CERTIFICATE OF MAILING
UNDER 37 CFR 1.8**

I hereby certify that this correspondence is being deposited with the United States Postal Service on this date, **17 October 2011**, in an envelope addressed to:

Commissioner of Patents
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P.O. Box 1450
Alexandria, VA 22313-1450

By: 

Donn K. Harms

RESPONSE TO SECOND REQUEST FOR INFORMATION

COMES NOW the Petitioner herein, Paxton (Pax) Beale, patentee and owner of U.S. Patent 6,221,836, responding to the Examining Attorney's most recent Request for Information in the petition to the U.S. Patent Office for relief in this matter under 37 CFR 1.378 on grounds of unavoidable delay despite Petitioner's exercise of reasonable and prudent diligence. Such relief is within the propriety of the exercise of the Honorable Commissioner's discretionary power in favor of Petitioner based upon the unique facts and circumstance of this particular case.

I. PROCEDURAL FACTS

Petitioner is the patentee and owner of for U.S Patent 6,221,836 (the '836 patent) issued April 24, 2001. The four year maintenance fee on the '836 patent was not timely received by the Patent Office despite Petitioner's actions in paying his attorney in advance and prudently calendaring and tracking the due dates for such payment.

II. LEGAL STANDARD

To maintain a patent in force, it is required that maintenance fees be paid to the Patent Office in intervals of 3 ½ years, 7 ½ years, and 11 ½ years from issuance, which fees may be paid by the patentee or any person acting on behalf of the patentee. *37 CFR 1.20(e); 1.362(d), (e)* (grace period); *1.366* (submission). Failure of the Patent Office to properly receive requisite maintenance fees results in the expiration of the subject matter patent. *37 CFR 1.362(g)*.

The applicable law, however, does permit acceptance of delayed payment after expiration, and reinstatement of patents. Such reinstatement lies within the inherent power of the Commissioner to grant upon a satisfactory showing by petition that, despite the exercise of reasonable care by the patentee, the maintenance fee, unavoidably, was not paid. *37 CFR 1.378; 35 USC § 41(c)(1)*.

The Commissioner's exercise of discretion is to be determined upon a case by case basis, guided and balanced by "taking all the facts and circumstances into account." *Smith v. Mossinghoff*, 671 F.2d 533, 538; 213 USPQ 977 (D.C. Cir. 1982). The balancing of the facts and circumstances is based upon the reasonable and prudent person standard. *Ray v. Lehman*, 55 F.3d 606, 608 (Fed. Cir. 1995) citing to *In Re: Mattullath*, 38 App. D.C. 497, 514-515 (D.C. Cir. 1913). Pursuant to the historic *Mattullath* standard, a standard of liberal interpretation and application, continues to be embraced as shown by the *Ray* decision by the Federal Circuit.

III. ANALYSIS

- A. Prior Shown Diligence of Petitioner and Reasonable Reliance on Attorney Nickey, Combined with the Terminal Illness of the Practitioner Charged with Paying Maintenance Fee Constitutes Unavoidable Delay**

Petitioner, in his initial petition and previous responses to the PTO's request for information, established that Petitioner treated the '836 patent the same as a reasonable and prudent person would treat his or her most important business.

The Examining Attorney, in the Request for Information Dated August 17, 2011, has requested Petitioner provide any information Petitioner has regarding the actions or inactions of his patent attorney, Don Nickey, relative to the non-payment of the maintenance fee, including information about Mr. Nickey's procedures for tracking, docketing, and for paying maintenance fees. Further, information was requested on how Mr. Nickey's illness may have affected his tracking, docketing, and the failure to pay the 3.5 year maintenance fee for Petitioner's patent.

Petitioner respectfully submits information herewith that the failure of Attorney Don Nickey, the patent attorney for Petitioner who timely paid Applicant's previous maintenance fees, and who Petitioner paid in advance and subsequently relied upon for payment of the Maintenance fee herein, and who it was known had an excellent docketing system and a consistently timely track record with other professionals, due to ongoing terminal illness and increasing substance dependence related thereto, failed to timely pay the maintenance fee herein.

Nickey's progressively worsening illness and dependency, which was unknown to the Petitioner at the time, coupled with Petitioner's reasonable reliance on Mr. Nickey from Nickey's flawless prior performance with Petitioner and other Professionals, and Nickey's prior timely maintenance fee payments, combined with the prior showing herein of Petitioner's personal diligence, constitutes unavoidable delay pursuant to *37 CFR 1.378*.

Substantiating the procedures and docketing of Nickey prior to the term of his terminal illness, Petitioner has attached hereto Declarations of Attorney Raymond N. Stella Erlach

(“Erlach Dec.”), Supplemental Declaration of Attorney Sean Casey (“Casey Supp. Dec.”), and Supplemental Declaration of Petitioner Paxton (Pax) Beale (“Beale Supp. Dec.”).

The Declarations of Erlach and Casey show that Don Nickey was a well respected attorney, with a reputation for excellence as a patent attorney and legal associate. Mr. Nickey was considered to possess expert knowledge in protein/pyruvate patents which was the impetus for Petitioner’s initial selection of Mr. Nickey as his patent counsel. With modern communications, the fact that their respective offices were geographically remote from one another was never an issue.

As attested to in the attached declarations, it is shown that prior to Mr. Nickey contracting a terminal illness and substance dependence related thereto, in addition to representing Petitioner, Mr. Nickey assisted, represented, or rendered legal services on pyruvate patents to University of Pittsburgh Medical Center, the foremost pyruvate researcher, Dr. Ronald Stanko, and multi-billion dollar a year Abbot Ross Laboratories. He subsequently worked as in house counsel for the multi-billion dollar a year Cardinal Health Corporation, one of three of the leading medical/drug distributors in the United States. These entities, collectively, have a host of pyruvate patents, mostly authored by Mr. Nickey.

As shown by the attached declaration of Erlach, Petitioner was represented by attorney Raymond N. Stella Erlach for litigation matters contemporaneous with Mr. Nickey’s representation of Mr. Beale before the U.S. Patent Office. (See, *Erlach Dec. Par. 4*).

As shown in the declaration of Attorney Erlach, during this representation, Attorney Erlach met with, and communicated with, Mr. Nickey on at least 57 separate occasions as reflected in Mr. Erlach older billing records and memory. Further, Erlach notes he likely

communicated many more times not reflected in Mr. Erlach's billings as Mr. Erlach does not bill for every communication. During these communications and meetings with Mr. Erlach, it is clearly shown that in fact Mr. Nickey had a calendaring and docketing system he used regularly. This is noted by Mr. Erlach's declaration in that he states Mr. Nickey specifically referred to his calendar and docketing system, stating he would "calendar" something or that he had something on his calendar.

As also stated in the Erlach declaration, it was often necessary for Mr. Nickey to provide information to Mr. Erlach on, or by, a certain date, or to attend a meeting or deposition related to the matter for which Mr. Erlach represented Petitioner, on a certain date at a specific hour. As noted, Mr. Nickey was always on time with his responses and always arrived on time and prepared for all meetings where his physical presence was required, including depositions. As Mr. Erlach, an attorney himself, notes, this performance and timely delivery, without fail, would not have been possible had Mr. Nickey not meticulously maintained and followed the calendaring and docketing system he frequently referred to in speaking with Mr. Erlach.

Additionally, Mr. Erlach notes that as part of Mr. Erlach's patent litigation representation of Petitioner, it was necessary for Mr. Erlach to review the Petitioner's patent portfolio including the patent file histories. Mr. Erlach noted during his reviews that he specifically saw that all PTO responses to requests for information, office actions responses, and issue fee payments for Mr. Beale's patents were timely submitted to the Patent Office by Mr. Nickey.

As noted by Mr. Erlach, an attorney himself, with years of practice, and as inferred by the Nickey's years of timely responses to Erlach, and to the patent office on every required occasion up through issuance of the patents, Mr. Nickey would have had to employ the

docketing/calendaring system of which he spoke on numerous occasions with Mr. Erlach during his interaction with him on trial matters. His actions during prosecution were always timely.

Based upon oral comments made by Mr. Nickey to Mr. Erlach, specifically regarding his calendar/docketing system, Mr. Nickey's punctuality with communications, meetings and depositions, as well as timely responses to the Patent Office by Mr. Nickey during prosecution of Mr. Beale's patents, up to the time of the onset of Mr. Nickey's terminal illness, Mr. Nickey must have had a meticulously maintained and followed calendaring/docketing system which was followed prior to the onset of his terminal illness.

Additionally, Attorney Sean Casey, a registered patent attorney, as noted in his Declaration attached hereto, knew and regularly communicated with Mr. Nickey. On occasions, when specifically requested by Mr. Nickey, Mr. Casey provided support services to Mr. Nickey. Mr. Casey also permitted use of his address for Mr. Nickey on a limited bases for private clients maintained by Nickey following his acceptance of an in house patent counsel position with Cardinal Health Corporation. Mr. Casey's support services to Mr. Nickey included assisting with issuance payment of the '836 patent.

Mr. Casey, as such, provides his information in his declaration through his personal knowledge, through communications with Nickey between 1998 and 2002. It is Mr. Casey's declaration, from this personal interaction with Nickey for more than four years, that Mr. Nickey maintained a detailed, accurate and regularly updated docketing system, for his private clients, including Petitioner.

Further, Mr. Casey confirms in his declaration that during his communications with Mr. Casey, Mr. Nickey orally referred to "docket numbers" as well as patent and application

numbers with which the dockets correlated. Mr. Casey confirms that when Nickey sent communications to Mr. Casey, those communications included what appeared to be print-outs from his docketing system which Mr. Casey states from personal knowledge that Nickey used for tracking his private clients and matters related to such dockets. Mr. Casey recalls that these print outs appeared to be from an automated docket system. Mr. Casey further recalls from personal knowledge, and interaction with Nickey, that Mr. Nickey used a well known computerized docketing and calendaring system to track the matters of his private clients, though he does not currently recall the exact name of the computerized calendaring and docketing program.

On the occasions when Mr. Nickey requested specific legal support services, Nickey was always the one to contact Mr. Casey. It was never the case that Mr. Casey contacted Mr. Nickey regarding deadlines as Mr. Casey did not maintain a docketing system for Mr. Nickey's clients. Mr. Nickey always contacted Mr. Casey well in advance of due dates and frequently referenced his (Nickey's) docketing system. Further, Casey states he does not recall a time when support services were requested "last minute" or on a "rush" basis. Specifically, it was Mr. Nickey who contacted Mr. Casey and asked for assistance from Mr. Casey in filing the issue fee due for Petitioner's '836 patent based on his computer docketing program.

Mr. Casey states in his declaration that he has first hand personal knowledge from statements by Mr. Nickey, and from personally viewing printouts of Mr. Nickey's docketing system, and from Nickey's timely performance and requests, that Mr. Nickey meticulously maintained and followed a computerized calendaring and docketing system to manage his private client matters and track private client deadlines. That it was Mr. Nickey that contacted Mr. Casey when support services were needed to meet a deadline supports that Mr. Nickey must have

meticulously maintained and followed this computerized docketing and calendaring system up to the onset of his terminal illness, which Mr. Casey states, in reviewing matters in hindsight, did affect Mr. Nickey's performance.

B. Liberal Standard of Application Supports Petitioner

Petitioner respectfully submits that the requirement of the exercise of liberality in favor of a petitioner seeking relief on grounds of unavailability as set forth originally in *Mattullath*, is the appropriate standard herein and supports grant of the petition herein.

Chief Justice Shepard, speaking for the Court, quoted with favor directly from the opinions of then Commissioner Hall:

The word "unavoidable" as used in (the Patent Laws) is one of a very broad significance. In its application to many relations it would exclude everything but the "King's enemies" or an act of God.

I do not believe such a construction would be a fair interpretation ...

The statute is one regulating a mere practice in the Office, and is not intended to affect substantial rights as between ... persons and the government. It is rather a provision by which a statutory provision may be removed. Its purpose is to encourage diligence in proceedings before the Office. If the broad and unlimited meaning of the word "unavoidable" were to prevail, it is difficult to conceive when (a patent) could be reinstated

In my opinion, the word is used in a more limited sense. It is applicable to ordinary human affairs, and requires no more or greater care or diligence than is generally used and observed by prudent and careful men in relation to their most important business. It permits them, in this exercise of this care, to rely upon the ordinary and trustworthy agencies of mail and telegraph, worthy and reliable employees, and such other means and instrumentalities as are usually employed in such important business.

If, unexpectedly or through unforeseen fault or imperfection of these agencies and instrumentalities, there occurs a failure, it may properly be said to be unavoidable, all other conditions of good faith and promptness in its ratification being present.

In Re: Mattullath, 38 App. D.C. at 514-515.

The *Mattullath* Court unequivocally endorsed Commissioner Hall's opinions, adopting same as the proper law of construction and application, stating, "The doctrine expressed by Commissioner Hall ... is broad and liberal, breathing the spirit of equity, and more in accord with the general policy of our patent laws." *Ibid*, at 515.

The same rationale applicable in finding that Mattullath did not "sleep on her rights" thus permitting reversal of expiration, is properly applied to Petitioner in this case.

C. Exercise of Reasonable and Prudent Care by Petitioner in this Case

As set forth above, the question of unavailability is akin to the equitable issue of "sleeping on one's rights" *Mattullath*, at 515. The test is whether or not under the specific facts of this case Petitioner exercised "the care or diligence (that) is generally used and observed by prudent and careful men." *Ibid*, at 514, directly cited with approval in *Ray*, 55 F.3d at 6109 (Fed. Cir 1995). Reference is made to the previous submissions and declarations which are included herein by reference. These previous submissions demonstrate conclusively that Petitioner treated the '836 patent the same as a reasonable and prudent person would treat his or her most important business. That Petitioner docketed it in Petitioner's calendar, that Petitioner paid the fees to Attorney Nickey in advance, that Petitioner checked with Nickey and conformed payment of an earlier-due maintenance fee, that Petitioner reasonably relied on Nickey to pay the fee herein, subsequent to Nickey timely paying the other maintenance fees, and subsequent to Nickey confirming he would pay the fee timely when communicating with Petitioner about it.

As the Declarations of Attorney Casey and Attorney Erlach show from their respective personal ongoing interaction with Nickey, unbeknownst to Petitioner, Mr. Nickey was suffering from a terminal illness over the period of time in question, along with a prescription drug

substance abuse resulting from his terminal illness.

Apparently, and unknown to Petitioner, these dire medical conditions resulted in Mr. Nickey departing from his prior years of timely executing and following his meticulous docketing system which resulted in unexpected and unanticipated problems caused by Nickey's actions, all of which impacted Petitioner's '836 patent. As shown in the earlier and current declarations and filings of Petitioner, such illness and addiction information was not only unknown to Petitioner, Petitioner was informed to the contrary, that his matters would be taken care of, specifically including the '836 patent maintenance fee when Petitioner inquired based on notations in Petitioner's calendaring system. Petitioner knew that patents required maintenance fees at set intervals and calendered such and inquired about such on all his patents. Petitioner, who during a long period of time was hospitalized and suffering from a potentially deadly illness, took all steps reasonable and necessary to be diligent, and was aware that Nickey had paid another maintenance fee from funds on deposit already, and had no reason to doubt Nickey's communications with Petitioner that the fee herein would be paid from the same deposited funds.

As a matter of law, Petitioner was, and is, entitled to rely on the information provided by his representatives. *Ray*, 55F.3d at 609 (Fed. Cir. 1995) citing to *Mattullath*, at 514-515.

D. A Finding of Unavoidable Delay and Reinstatement is Equitable and Proper

It is respectfully submitted that Petitioner did all things reasonable and prudent with respect to seeking to maintain the '836 patent. Petitioner calendered such himself, deposited funds with his attorney, checked with his attorney based on Petitioner's calendaring system, confirmed a first maintenance fee was paid as his attorney had indicated, and Petitioner relied on his attorney to pay the second fee from the same funds on deposit when his attorney said he

would do so timely, just as in the first payment.

A series of events wholly outside the control of the Petitioner occurred during the relevant time period. The historic holdings of Commissioner Hall (as embraced by the Courts) continue to guide us in this matter, . which holdings establish that *37 CFR 1.378*, *35 USC § 41*, and *35 USC 133* should be applied liberally in favor of a Petitioner. The statutes “purpose (being) to encourage diligence in proceedings before the Office.” *Ex parte Pratt*, 39 Off. Gaz 1549; 1887 C.D. 31.

It is further respectfully submitted that it is shown by the attached declaration of two attorneys, having personal knowledge, and by inference through the actions of Mr. Nickey over years, that Petitioner’s patent counsel Mr. Nickey, meticulously maintained and followed an automated docketing system for his private clients, including Petitioner Beale. Further, it has been shown that this system and timely behavior continued up to the onset of a terminal illness of Nickey, which resulted in the untimely death of Mr. Nickey at the age of 57 .

From the first hand declarations of two Attorneys with personal knowledge, it has been shown that the onset of Mr. Nickey’s terminal illness impacted Mr. Nickey’s professionalism, and due to his own illness and substance addiction, this impact on his own performance was most likely unknown to Mr. Nickey, who had previously performed with excellence in a meticulous fashion.

This impact in performance and professionalism by Nickey, as noted by first hand knowledge of the declarations of other Attorneys attached hereto, coincided with the time for payment of the ‘836 maintenance fee. As noted by the declarations of the attorneys attached hereto, it was unlikely that anyone who did not interact with Mr. Nickey on a regular basis,

would notice his falling performance and errant behavior. Consequently Petitioner, who reasonably relied on his Attorney and Mr. Nickey's confirmation of performance of his duties when asked, would have had no way to know that something was amiss.

As a case by case review is standard in these matters, the balancing of the facts peculiar to this case establishes, that Petitioner has shown that "unavoidable delay" occurred within the meaning the statutes as construed by case law. Petitioner did not "sleep on his rights", rather Petitioner actively worked himself to comply, and he appropriately relied on representatives verbal assurances of a registered patent attorney with a previous record of flawless performance and prior timely payment of maintenance fees, and had no way of knowing a terminal illness caused a change in that prior performance, all of which meets the standard requiring no more or greater care or diligence than is generally observed by prudent and careful men.

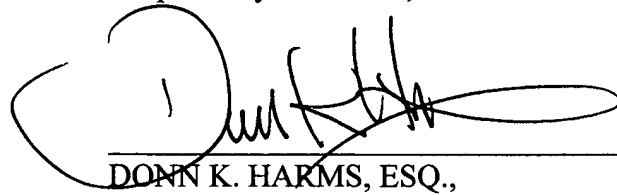
Clearly, the facts unequivocally establish that the '836 patent was abandoned due to an unavoidable delay. The Commissioner has the inherent power to grant the petitioned relief for such unintentionally abandoned patents where it is shown to the Commissioner's satisfaction that the delay unavoidable.

III. CONCLUSION

For the reasons set forth in the records of this Petition, as supported by the testimonial and documentary evidence filed herewith and prior hereto, it is respectfully submitted that the Honorable Commissioner find that the facts meet the requisite threshold to find there was unavoidable delay in the payment of the maintenance fee herein, thus permitting acceptance of the previously paid fees and surcharges and ruling the '836 patent to be "considered as not having expired at the end of the grace period."

Respectfully submitted,

Dated: October 17, 2011

A handwritten signature in black ink, appearing to read 'Donn K. Harms', is written over a horizontal line. The signature is stylized with a large initial 'D' and a long, sweeping horizontal stroke at the end.

DONN K. HARMS, ESQ.,

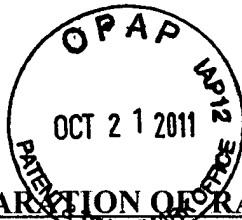
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**DECLARATION OF RAYMOND N. STELLA ERLACH IN SUPPORT OF PETITION
FOR ACCEPTANCE OF UNAVOIDABLY DELAYED MAINTENANCE FEES**

I, RAYMOND N. STELLA ERLACH, do hereby declare as follows:

1. I am over the age of 18 and make this declaration of my own personal knowledge.
2. At all times from 1973 to the present, I have been an attorney licensed to practice by the State of California. I myself do not prosecute patents and I am not licensed to practice before the Patent Office.
3. My law office represented Petitioner Pax Beale from 1996 through 1999 in the United States District Court in litigation over patents and use claims involving protein/pyruvate compounds, for most of which I was lead counsel.
4. During the time I acted as trial counsel for Mr. Beale, Mr. Beale's protein/pyruvate patent portfolio was handled by Attorney Don Nickey. Mr. Nickey was a registered patent attorney who had a reputation for excellence as a patent prosecutor, which I learned from my interactions with people who knew him. He also was one of the few patent attorneys who had expert knowledge in the field of protein/pyruvate patents. From my memory of dealing with Mr. Beale and Mr. Nickey at the time, I remember Mr. Nickey handled virtually every aspect of the prosecution of Mr. Beale's patents including resolving issues raised by examiners and payment of issue fees.
5. In my function as Mr. Beale's trial counsel, especially during the extended period of patent litigation before the District Court, it was necessary for me to communicate with Mr. Nickey on numerous occasions. Mr. Nickey assisted me tremendously in protecting Mr. Beale's patent claims in the court action, which resulted in a very successful settlement in Mr. Beale's favor, including acquiescence in the validity of Mr. Beale's patents.
6. Mr. Nickey, in his role as patent counsel, authored and/or rendered legal services on pyruvate patents involving the University of Pittsburgh Medical Center, Dr. Ronald Stanko, at one time reputed to be the foremost pyruvate researcher, and multi-billion dollar a year Abbot Ross Laboratories. He subsequently worked as in house counsel for the multi-billion dollar a year Cardinal Health Corporation, one of three of the leading medical/drug distributors in the United States. These entities, collectively, have a host of pyruvate patents, mostly authored by Mr. Nickey. All of these entities had activities centered around Mr. Nickey's office area of Columbus, Ohio and/or Pittsburgh, Pennsylvania. Mr. Nickey was at the center of almost every key pyruvate patent, and performed detailed patent work for all those entities, in addition to Petitioner Beale. Pyruvate patents were issued to a host of staff members at University of Pittsburgh Medical Center, and Abbott Ross Laboratories.
7. Mr. Nickey was the key patent coordinator/author for almost all of the patent work involving the entities listed in Paragraph 6 above prior to becoming "in-house" counsel for Cardinal Health until his death. Mr. Beale chose to work with Mr. Nickey, despite the geographical differences in their domiciles, because of Mr. Nickey's extensive pyruvate patent

knowledge. Mr. Nickey could not have performed professionally with such sophisticated clients without a functioning, properly monitored docket system.

8. I had no less than twenty-six (26) telephone conferences and face to face meetings with Don Nickey concerning the pyruvate patents involved in Mr. Beale's litigation. (I say *no less than*, only because the itemized billings during the period 10/04/96 to 04/16/99 reflect twenty-six conversations with Mr. Nickey. There were likely many more, however I do not bill for short telephone calls and other conversations beyond the 26 itemized in the billings likely occurred).

9. I also had no less than thirty-one (31) exchanges of correspondence of substance with Mr. Nickey during that period concerning the pyruvate patents.

10. I also had no less than eight (8) conversations of substance concerning the pyruvate patents with responsables from Mr. Nickey's office, including patent attorney Sean Casey who I understand assisted Mr. Nickey on projects from time to time when specifically requested by Mr. Nickey to do so.

11. I also obtained Mr. Nickey's prosecution files on the patents in question in the litigation and reviewed them for privilege and work product doctrine protections. I discussed calendaring and docketing records with Mr. Nickey and to my best recollection obtained a waiver as to production of same from the opposition in the litigation, as maintenance to be performed in the future was not of relevance and was not material to the issues in the litigation, which related to claims of infringement, unfair competition, dominance and claim construction.

12. Because of the nature of our communications and both of us having busy calendars and Court procedural filing requirements, it was often necessary for Mr. Nickey to respond to me at a certain time, or by a certain date. This timely response requirement occurred throughout the trial proceedings. From my personal experience in ongoing dealings with Mr. Nickey, I can say that he was always on time with his responses. I am aware Mr. Nickey had a calendaring system because on numerous occasions he said he would "calendar it" or indicated on some occasions he had another matter calendered on a potential day for a communication time between us. Further, he never missed a procedural deadline, which I or my staff communicated to him for a response, and which was needed for a submission by my office.

13. Mr. Nickey's oral comments concerning his calendar and his docketing, and such detailed and timely responses, would not have been possible had Mr. Nickey not meticulously maintained an accurate docketing and calendaring system.

14. In addition to always timely responding to my communications or requests for information, or other matters, scheduling the deposition of Mr. Nickey was part of the discovery process for a trial matter I was handling. Again, I remember Mr. Nickey indicating he needed lead time for his deposition, so he could fit it into his calendar. He must have docketed and

maintained that calendar because Mr. Nickey was always present where his presence had been requested in advance. Further, for each appearance, he always arrived prepared and on time. As a fellow attorney, who also must calendar everything on my docket, and because of his comments regarding calendaring, I have no doubt that his presence, punctuality and preparedness were the result of an accurately and meticulously maintained docketing/calendaring system. The discovery deadlines in a trial generally yield many meetings, depositions, written responses, and other matters which must occur on certain dates at certain times. Mr. Nickey never missed a meeting or a requested response. Thus, I know as an attorney that such timely responses and attendance at numerous meetings at numerous venues at varying times would not have been possible absent such a well maintained calendaring system.

15. Additionally, during the time I acted as Mr. Beale's trial attorney, it was necessary for me on many occasions to review Mr. Beale's patent portfolio and the file transaction history as appearing in Mr. Nickey's records. The purpose was to ascertain any weakness or mis-filing during the prosecution histories. During such reviews and inquiries, I remember noting that all responses to requests for information, office actions response, and issue fees for Mr. Beale's patents had been timely submitted to the Patent Office by Mr. Nickey. Again, having litigated the validity of patents and reviewed the "wrappers" and file histories, I know that in order to timely respond to the patent office on every required occasion up through issuance of the patents, Mr. Nickey would have had to have employed the docketing/calendaring system of which he spoke during our interaction on trial matters as described above in Paragraphs 8 through and including 11. His actions during prosecution had always been timely. As a result, I conclude Mr. Nickey would have had to maintain the calendaring system for his docket, of which he spoke, with extreme accuracy and meticulousness.

16. After the litigation ended, my communications with Mr. Nickey became far less frequent. Through Mr. Beale (who I continued to represent on other matters), I was aware Mr. Nickey continued to work with Mr. Beale on the pyruvate patent portfolio as issues on the judicial claim construction and interpretation of prior art arose. Later, I came to learn through third parties that Mr. Nickey suffered serious medical problems. I learned he eventually passed away at the relatively young age of 57, from what was reported as a serious medical illness. While I did not have first hand knowledge of Mr. Nickey's medical problems since he operated from an Ohio office, and I from California, I was informed by mutual acquaintances that Mr. Nickey was suffering problems from a serious illness and from the side effects of prescribed medicines for that serious illness.

17. From my personal dealings with Mr. Nickey, I am certain it could only have been his serious medical issues which affected his handling of his professional duties. This is because in my dealings with Mr. Nickey, he was a consummate professional, he only exhibited on-time performance, through dozens of deadlines over the years of trial matters. His serious medical problems can be the only explanation for his failure to pay Mr. Beale's patent maintenance fee, for the patent at issue. His sudden change, from years of habitual calendaring, and on-time actions, can only be attributed to his reported medical problems, which apparently became increasingly serious about the same time as his professionalism suffered. I can say this with

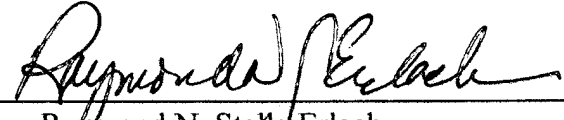
confidence, because when I knew and worked with Mr. Nickey during the litigation, prior to his illness, I personally knew him to be meticulous with responses, filings and meetings as noted above.

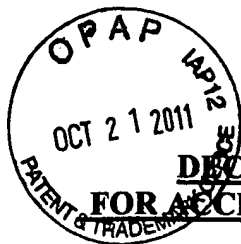
18. Through my extensive interactions with Mr. Nickey over a period of several years, I experienced first hand Mr. Nickey's excellence as a patent attorney. My personal experience in dealing with Mr. Nickey, through the years of trial work, and his technical contributions to substantive matters in my trial work, reflected his on time performance. That involved supporting my discovery deadlines, deposition preparation and appearances, and the numerous conferences and communications outlined in paragraphs 8, 9, 10 and 11 above. This work was necessarily prescheduled and required to be consummated in tight and restricted time scenarios under the Federal Rules of Civil Procedure and the District Court's scheduling orders. Mr. Nickey's comments, about calendaring when deadlines were discussed, leads me to believe that only his reported onset of terminal illness, and health problems in later years, could have resulted in Mr. Nickey uncharacteristically abandoning his prior years of professional and on-time performance.

I declare under penalty of perjury under the laws of the State of California that the foregoing is true and correct. Executed on the 12th day of October 2011, at

San Francisco, California

By:


Raymond N. Stella Erlach



**DECLARATION OF SEAN CASEY IN SUPPORT OF PETITION
FOR ACCEPTANCE OF UNAVOIDABLY DELAYED MAINTENANCE FEES**

I, SEAN CASEY, do hereby declare as follows:

1. I am over the age of 18 and make this declaration of my own personal knowledge.
2. At all times from 1998, to the present, I have been registered as an Attorney licensed to practice before the US Patent Office.
3. As I indicated in my previous Declaration herein, since 1998, I knew, and regularly communicated with, Petitioner Pax Beale's ("Beale") former Patent Attorney, Donald O. Nickey ("Nickey"). In his work with Abbott Ross Laboratories, and later when I worked directly with him at a former law firm, I found Mr. Nickey to be detail-oriented, meticulous, and highly diligent in his law practice, and while dealing with client scheduling matters.
4. As noted in my previous Declaration, when Mr. Nickey left private law practice for an in-house position with Cardinal Health Corp. in Ohio, I provided Mr. Nickey with support for the few private practice clients he continued to serve. As I recall, those private practice clients were people with whom he had developed personal friendship, and for whom he could offer legal services at good a value because of his technical background and experience. On limited occasions, I provided Mr. Nickey a mailing address to use for patent prosecution activities before the US Patent Office for those private clients. I also remember that Mr. Nickey continued to be of service as a patent attorney to Petitioner Beale.
5. The use of my office by Mr. Nickey was limited exclusively to use as a mailing address as a personal courtesy to Mr. Nickey. I was not regularly involved in Mr. Nickey's private client practice except as specifically requested. Even so, I regularly spoke with Mr. Nickey about his private practice clients as well as his Cardinal Health activities between 1998 and through about early 2002. Since 1998, I came to personally know Mr. Nickey to be a reliable, diligent, and detail-oriented individual who continued to provide competent help to his private clients.
6. When specifically requested on limited occasions, I sometimes provided legal support services for Mr. Nickey. This, as I noted in my earlier declaration, included assistance to Mr. Nickey with payment of the issue fees for the patent at issue, Patent Number 6,221,836 ('836).
7. I remember, as noted in my earlier declaration, these on-request support services that I performed for Mr. Nickey, included assisting with payment of the '836 issue fee, and related reviews, which Mr. Nickey specifically requested in my communications with him. I only specifically remember these interactions because of Mr. Nickey's stated importance of this case to his client, Petitioner Beale.
8. I was not asked the question for my first Declaration, but I remember, from those communications with Nickey between 1998 and about 2002, that Mr. Nickey maintained a

detailed, accurate, and regularly updated docketing system for his private clients, which included Petitioner Beale.

9. The reason I remember, and am aware of his docketing system, is that during our communications, he used docket numbers as well as patent and application numbers with which the dockets correlated. Related thereto, Mr. Nickey sent me email communications that included what appeared to be print-outs from his docketing system related to such dockets. From these communications, I knew that Mr. Nickey's docketing system was used specifically for the support services he provided to his private clients. For purposes of making this declaration, and in thinking back about my conversations and email communications with Mr. Nickey, I remember that I confirmed personally when we saw one another in-person, by email, and/or verbally by telephone conversations, which client application number and/or client name matched which client docket number in his docketing system. Mr. Nickey always responded with written confirmation that included what appeared to be the above-noted print-outs from his docketing system.

10. On the occasions when Mr. Nickey and I communicated about support services for paying fees for his remaining clients, and for purposes of using my mailing address, I also remember our communications about client matters included filing dates and payment due dates. This included patent fee issuance and maintenance fee due dates, which came up on his automated, docketing system. Mr. Nickey always initiated the communications between us as a result of events that came due on his automated docketing system, whereafter he asked me for support services for a particular private practice client.

11. Mr. Nickey was always attentive to contacting me and scheduling support services in a timely fashion, well in advance of due dates. I do not recall any instance where Mr. Nickey contacted me for support for a "last minute" or "rush" activity. Instead, I always recall having more than adequate time to attend to his requested legal service support activities. It was clear to me that Mr. Nickey was using an automated docketing system, because he would include the above-mentioned print-outs there from in his written requests for support. Given the intense demands and tempo of his duties for Cardinal Health, and from my own personal experiences, it was also clear to me that he could not have remembered upcoming dates and events related to his private clients unless he was regularly maintaining and using such an automated docketing, calendar, reminder, and tickler system. An example of Mr. Nickey's regular use of this automated docket and calendaring system, described in other words, is evident to me by the fact that even though I did NOT maintain any docketing system entries on behalf of Mr. Nickey's private clients, Mr. Nickey always timely contacted with me to request support for his private clients well in advance of any due date. This was specifically true for the due date for the issue fee for Petitioner Beale's '836 patent. I remember this because through conversations with Mr. Nickey over the years, I came to personally know that Petitioner Beale was a favorite client of Mr. Nickey. Thus, I remember that Mr. Nickey initiated a call to me regarding the '836 patent issue fee due date, for which he needed support services. From this and other unrelated but similar activities, I infer that Mr. Nickey's automated docketing system was working properly.

12. Pursuant to the request for my first Declaration, I have thought about my communications with Mr. Nickey over the years, regarding support services he needed for his

private clients. I remember communicating about his docketing system, and tickler files, and the fact he had to enter matters himself to remind him of due dates. We mutually reflected during conversations that these required docketing activities established our mutual appreciation for the efforts of our present and former legal support staff, who had assisted us in ensuring our docketing systems were working properly. I remember during these communications that he specifically noted his then-current docketing, calendaring, and tickler system involved a computer and a then-well-known-docketing software system, which he had continued to use and maintain from our days in private practice together. While I remember using the same system for a while, I no longer specifically recall which of the then-well-known computerized docketing systems he was using.

13. In late 2001, or early 2002, Mr. Nickey personally informed me that he would attend to payment of Petitioner Beale's upcoming maintenance fees for the '836 patent, because he had a more personal relationship with Mr. Beale than any other of his remaining private clients. In view of my long experience with Mr. Nickey's excellent reliability and diligence in acting on behalf of his clients, I had no reservations that Mr. Nickey would timely make this routine payment.

14. I spoke with Mr. Nickey sometime in early to mid-2004, around the time the first maintenance fee was due for the '836 patent. The conversation was primarily focused on discussing with Mr. Nickey third party information I had heard that he was experiencing serious health problems, which had started to impact his ability to work. I found out sometime later in 2008, that Mr. Nickey had worked under substantial duress due to such health issues since that time in early 2004, and had finally passed away in 2008, at the age of 57.

15. In hindsight, and thinking occasionally about Mr. Nickey since I had drafted my first Declaration, I now perceive that there were parts of my 2004 conversation with Mr. Nickey that could have lead me to believe that Mr. Nickey's medical issues were causing him more problems than he was willing at that time to admit or discuss. However, I do not think that anyone other than Mr. Nickey's closest associates would have perceived these circumstances, nor would anyone have been able to reach this conclusion or perception. In our 2004 conversations, we discussed his leaving Cardinal, and I now perceive that parts of the conversations were non-sensical and/or disjointed, which at the time I most likely dismissed and attributed to his usually heavy work-load and daily tempo at Cardinal. In looking back from today, I now believe Mr. Nickey may have been concealing a more serious condition, which may have been affecting him mentally, and which caused him to make the non-sensical statements and to comment he would leave Cardinal. In reality, I was later informed from third parties, and now believe that Mr. Nickey did not leave Cardinal right away, but struggled to meet his duties there until his departure, and subsequent unexpected and untimely death.

16. In my last conversation with Mr. Nickey in about 2004, I inquired how Mr. Nickey was doing, since I had heard from third parties he was ill, and was interested to know whether I could help with his private clients, and whether his illness was affecting his ability to handle Cardinal's legal matters. If Mr. Nickey had asked, I would have provided any support services, but our conversation centered on his health and his conviction that he continued to handle his work

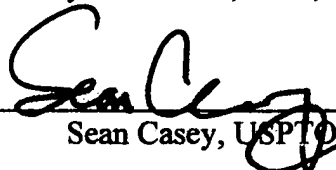
with private clients and at Cardinal. I do remember he did state he stopped working for most of his private clients, and that what remained, he could easily handle without my support.

17. In light of the third party communications I had up to that point about Mr. Nickey's health, and how such affected his private client and Cardinal work, I believe now that Mr. Nickey was more seriously ill than he was admitting to others, and personally wanted to admit to himself. From my confidential conversations with mutual friends and acquaintances, I now also speculate with confidence that Mr. Nickey did not realize his illness was affecting his mental ability to work diligently on behalf of Cardinal and his remaining private clients. However, others who did not have the same mutual friends and acquaintances of Mr. Nickey and me, and personal knowledge of Mr. Nickey's pre-illness and subsequent demeanor and legal prowess, would likely not have had any reason to suspect that Mr. Nickey was suffering from a diminished ability to be of service in a legal capacity.

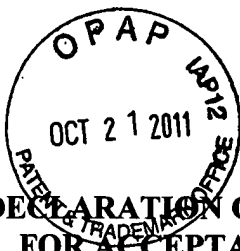
18. I later became aware through third party communications that Mr. Nickey's condition worsened over the years after 2004 until he died in 2008 at the age of 57. Looking back on my conversation with him in about 2004, and third party communications proximate in time, I now believe that Mr. Nickey's deteriorating health caused intermittent, if not regular problems with his performance on behalf of Cardinal as well as his few remaining private clients. I also believe that since I had not received requests for support, his deteriorating health had also impacted his ability to diligently attend to maintaining his docketing system and to act on reminder and tickler events arising therein.

19. However, as indicated above, without my personal knowledge of Mr. Nickey's illness, and the combined retrospectively relevant information received from third parties who also knew Mr. Nickey during the years between 1998 and 2008, I believe that most people would NOT have had any reason to suspect that Mr. Nickey was suffering from a serious illness affecting his mental capacity. Further, in view of his untarnished past reliability and diligence, most people would not have any reason to suspect that Mr. Nickey was experiencing any problems that affected his reliability and ability to act on their behalf. In view of my personal experience with Mr. Nickey's diligence exercised for his employer Cardinal and private clients, I believe that the only satisfactory explanation is that Mr. Nickey's illness was so severe, it detrimentally impacted (1) his mental ability to ensure he acted diligently on behalf of his clients, and (2) his ability to ask for support.

I declare under penalty of perjury under the laws of the State of California that the foregoing is true and correct. Executed on the 17th day of October, 2011, at Seal Beach, California.

By: 
Sean Casey, USPTO #39514

Sean Casey
PO Box 1095
Sunset Beach, CA



**DECLARATION OF PETITIONER PAXTON BEALE IN SUPPORT OF PETITION
FOR ACCEPTANCE OF UNAVOIDABLY DELAYED MAINTENANCE FEES**

I, Paxton (Pax) Beale, declare as follows:

1. As stated in my previous declaration, incorporated in it's entirety by reference herein, I am the sole inventor and sole owner of U.S. Patent No. 6,221,836 for Composition of pyruvate and anabolic protein and method for increasing fat loss in a mammal.

2. I note declarations by attorneys frequently outline their expertise in detail, so not to be upstaged, I'll follow the same format. With pride, as opposed to legal sophistication, I am known for the following.

a. I confess to being a fitness zealot.

b. I have created a specific prescription method of training, to attack the fact that every other person you meet today will die from heart disease, or stated more succinctly, a staggering 50%.

c. I have developed a specific nutrition program to combat the 50% death rate from heart risks.

d. I am a proponent of the concept of Total Commitment, wherein effort, even if it yields failure, can contribute to enhancing one's self-esteem.

c. I'm more committed to business and entrepreneurial efforts than to athletics, but herein, I emphasize athletics because they seem to be a common, easily understood communication tool, compared to the more bland subject of business.

d. I graduated from the University of California Berkeley in 1952.

I'm the only person who, in the over 100 year history of the University of California, ever represented the University against other major institutions in four sports: Member of the 1951

Rose Bowl football team, basketball, track and field as a shot putter, and boxing as a participant in the 1952 pre-Olympic trials.

e. Unrelated to the University, I raced an Ocean liner from San Francisco to Alaska, on a two-man bicycle relay team...and won by six hours.

f. I'm the only person in history to ever swim from San Francisco to Alcatraz in the pitch dark of night, in the coldest month of the year, with no fins or wetsuit.

g. I ran Death Valley in the hottest month of the year.

h. I have been acknowledged as the world's first triathlete. It's now a recognized Olympic sport.

i. Co-founded the first "run for fun" joggers' club, which filled the void that existed for recreational exercise for the working masses, after the public left the athletic programs fostered by their educational institutions. My joggers' club preceded Nike, the use of the term "aerobics," and paved the way for the birth of Gold's and 24 Hour Fitness type commercial gyms, yoga, master's swimming, and stationery bikes.

j. Our jogger's club initiated the creation of the circulation pool to allow Runner's World Magazine to be born, and the title of the magazine was formalized in my business offices.

k. I commercialized the first plastic cottage cheese container, making waxed paper containers obsolete, under the aegis of the Beale Container Corporation. Sounds trivial, but it was an enormous step forward in the packaging industry.

l. I subsequently owned two acute general hospitals and 11 outpatient surgery centers, where I structured the two year monitoring system based on detailed docketing of all

surgeries performed by the staff of medical doctors. I then reviewed details and percentages of complications for each doctor. The doctors were graded, and this entire process was dependent on the detailed docketing system for success. This had never been done before, or since to my knowledge.

m. I founded a unique drug rehabilitation operation, which occupied one wing of my acute general hospital. The program was coordinated with Alcoholics Anonymous, and relied in part on exercise to stimulate the natural opiates of the brain, and defeat addiction. I have a recorded TV endorsement from a University of California cardiologist, proving the reversal of my heart disease based on the synergistic effect of a system I researched and developed myself (available upon request). I said “reversed,” not “reduced!” No, I don’t profess it’s a cure-all for everyone.

n. Reversed the negative opinion of weight-resistance training as a tool to combat heart risks, subsequently approved by the American Heart Association and Harvard. More recently, I have founded a 501(c)(3) Nonprofit Organization solely dedicated to reversing the appalling 50% death rate from heart risks. My interest in the patent subject to resubmission herein, directly impacts the goal of the IRS recognized Body For The Ages 501(c)(3) Nonprofit Organization, which I founded.

3. I contracted with patent attorney Don Nickey, whom I refer to herein, and I referred to affectionately in the past, on a personal basis, as “Nickey.” My contract with Nickey’s services started on or about 1996, and continued through to the day of his death. I have routinely, and intermittently, contracted with Attorney Raymond N. Stella Erlach for well over fifteen years. I have also worked with Attorney Sean Casey through my contract with attorney Nickey when

assistance by Casey was specifically requested by Nickey. Casey resides in the area of Columbus, Ohio. Nickey had Casey handle some clerical items Nickey's private client overload was excessive, or for a select purpose. They were not partners in the practice of law.

4. Nickey's offices were in or around Columbus, Ohio. Selecting Nickey as my patent attorney, I believe made sense, because he was a "walking encyclopedia" on pyruvate, and sophisticated in protein technology. Despite the geographical distance between myself and Nickey, he was "my man."

5. Upon information and belief, Nickey had been the in-house attorney for the giant drug/medical products firm of Abbott Ross Corporation, whose headquarters I'm informed were in Columbus, Ohio. Nickey wrote most of the pyruvate patents, if not all of them, generated by the research department at Abbott Ross (now I believe it's just Abbott). Abbott Ross financially underwrote the pyruvate research lab at the University of Pittsburgh for approximately ten years. Nickey also was involved in patents for pyruvate research guru, Dr. Ron Stanko, the University of Pittsburgh Medical Center, and he was completely versed on a couple of pyruvate patents generated out of the Armed Forces Hospital in Bethesda, Maryland. Nickey was also familiar with the University of Pittsburgh Medical Center's distributor, Med-Pro Industries. For a time, he was in private practice in the Columbus, Ohio area, and ultimately he became the in-house council for the multi-billion dollar per year revenue producing Cardinal Health Corporation, a drug distributor also in the Columbus, Ohio area.

6. In selecting an attorney, I did extensive research. I selected Nickey, because I wanted the best in his patent area of interest. I can attest without reservation to his professionalism and sophistication. He was arguably the foremost pyruvate patent attorney in the world. He proved

that to me repeatedly, not only with his knowledge, but his professionalism, including time frames involving depositions, meet and confer sessions, processing my patent applications, creating my patent applications, and for years, paying every type of fee required in patent processing and renewal. Of course, I reference Nickey's professionalism before the onset of terminal illness and prescription drug dependency.

7. Nickey, or anybody for that matter, could not have performed at his level without a system to monitor his performance. I guess attorneys call it a "docket system," but as a bodybuilder, I call it my "programmed workout," and as a businessman, my "business schedule." The term docket is foreign to me, as part of my common discourse, but endeavor to use the term docket to stay on track in communicating with my attorneys and the PTO.

8. Nickey did not go public with his terminal illness or resulting addiction. Consequently, Nickey's medical problems, which impacted his handling of my patents matters, were unknown to me until I learned that he had died at the age 57, and his failure to pay the maintenance fee for my '836 patent. I did not know at the time, but now know, that Nickey's diminished contact with me coincided with the onset of his terminal illness. However, when my calendar/docket suggested a patent maintenance fee was due to be paid, I contacted Nickey for confirmation. Nickey assured me he would attend to payment of the maintenance fee with money I had left on retainer with Nickey as he had done previously for other payments due for my patents. Verbal confirmations from Nickey gave me assurance that he was continually prepared to renew maintenance fees. The unfortunately reality, of which I only later became aware, was that Nickey was, at the time of these assurances, in a state of severe physical and mental decline.

9. Nickey was really a “nice guy,” ethical beyond a doubt, and proved his fidelity to me with his professional contributions. Additionally, Nickey and I had other common interests. Nickey had a young, athletic son who had a penchant to play football. I now remember Nickey using the words that he wanted to docket a step by step program to be implemented by his son, involving both nutrition and weight-resistance training. I laid out a two year program of weight-resistance training for his son. At that time, “docket” wasn’t part of my routine language. However, Nickey referred to the information I gave him for his son as something he wanted to docket. He said he wanted to docket the protocol for the entire program two years in advance. He explained to me that the jargon in the legal profession was that a successful attorney should have a docket. He said in the legal profession there was a greater demand for a docket than others, especially patent law. I remember him telling me patent law was highly detailed, and you had to monitor every facet of every patent, because it was impossible to keep them in your memory.

10. For Nickey’s son, I dictated for Nickey to docket every workout day for two years, but I dictated detailed instructions on the specific muscles and number of muscles to workout on a specific day, the amount of resistance by weight for each exercise, the number of sets of each exercise, the number of repetitions in each set of exercise, and the recovery/rest time between sets.

11. I provided the schedule to Nickey via telephone and he created the docket and referred to it as a docket. Nickey’s son ultimately matured, graduated from high school, and went to play football for Ohio State University. Both Nickey and I felt good about that fact, and it cemented our relationship.


12. In my previous Declarations and submissions, I conveyed actual dates of my repetitive hospitalizations. However, since December 2010 through the date of the origin of this declaration in September 2011, I was hospitalized additionally on three distinct and separate occasions, plus I had walking pneumonia. I know what it's like to be so incapacitated that you just don't care anymore. I have empathy for Nickey's inability to function at a high level of professionalism as his health declined, because I've had more than one near terminal illness myself, except I'm still here to chase my dream. My point is that when you get so low in physical and mental strength, and as you proceed toward that state, good people can routinely fail to keep their commitments. Besides, you don't have the strength to care anymore. Don Nickey was a good man. Don Nickey was a decent man. He died at 57.

13. I offer my testimony that I saw evidence that Nickey had a docketing system, albeit it was his son's two year weight-resistance training schedule, but Nickey did explicitly make reference that his son's docketing system was implemented the same way he operated the docket system he employed for his law practice. Nickey's terminal illness was not revealed to me and was not under my control, nor under the control of Nickey, a dying man.

I declare under penalty of perjury under the laws of the state of California that the foregoing is true and correct.

Executed on the 14th day of October, 2011, at San Francisco, CA.

By:



Paxton (Pax) Beale, Petitioner